

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1-20 are pending in this application. By this Amendment, claims 1, 2, 6, 11, 13, 14, 16, 19, and 20 are amended. The amendments are made solely for purpose of clarification, and not related to patentability. No new matter is added. Claims 1, 13, 14, 19, and 20 are the independent claims.

Applicants note with appreciation the Examiner's acknowledgement that certified copies of all priority documents have been received by the U.S.P.T.O.

Applicants also appreciate the Examiner's indication that the Information Disclosure Statements filed on May 12, 2005, October 31, 2005 and July 30, 2007, have been considered.

Applicants also respectfully note the present action indicates that the drawings have been accepted by the Examiner.

Claim Objections

Claim 13 is objected to under 37 C.F.R. 1.75(c) as being improper dependent form for failing to further limit the subject matter of a previous claim.

Applicants have re-written claim 13 as independent form, including all of the features of claim 1, as suggested by the Examiner. Withdrawal of the objection is respectfully requested.

Claim Rejections - 35 U.S.C. § 112

Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which Applicant regards as the invention. Applicants respectfully traverse this rejection for the reasons discussed below.

In particular, claim 1 is rejected for being unclear, e.g., if claim 1 is claiming a method of making or a product of the floorboard. Applicants have amended claim 1 to recite that the “floorboard adapted to be used for making a resilient floor by joining to at least one neighbouring, substantially identical floorboard.” In other words, the floorboard according to claim 1 is adapted to be used for making a resilient floor by being joint to other (substantially identical) floorboards. As such, claim 1 is claiming the product, i.e., the “floorboard,” and not the method of making a floorboard or a floor.

Further, the Examiner asserted that claims 1-12 are understood to be “product-by-process” claims. In view of the above and instant amendment, Applicants respectfully submit that claims 1-12 are not product-by-process claims. In fact, Applicants note that sufficient coverage is provided for the method of making the floorboard, see, e.g., claims 19 and 20.

In addition, claim 1 is further rejected for being unclear how the floorboard is made, e.g., “if the floorboard is the nearing boards joined together,...is the floorboard comprised of boards joined together.” Applicants submit that the floorboard is not made by “...joining at least one neighbouring identical floorboard,” but, as mentioned above, “*a resilient floor is made by joining floorboards.*” Accordingly, it is respectfully submitted that the floorboard is not comprised of boards joined together.

In regard to claims 2, 6, 7, and 11, Applicants have amended these claims to provide proper antecedent basis.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 14-17, 19 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,006,486 ("Moriau"). Applicants respectfully traverse this rejection for the reasons discussed below.

Applicants respectfully submit that the Moriau reference fails to disclose or suggest each and every element of claim 1, and therefore, an anticipatory rejection has not been established.¹

For example, claim 1, as amended, recites, *inter alia*:

a resilient base, arranged on an underside of the floorboard and extending beyond said joint plane,

a supporting layer, arranged between the underside of the floorboard and the resilient base.

In particular, Applicants respectfully submit that the Moriau reference fails to disclose or suggest, "*a resilient base*," as taught by amended claim 1.

In the outstanding Office Action, the Examiner contends that the backing layer 58 of Moriau corresponds to a "resilient base." (*See Office Action mailed October 2, 2008, page 4, first paragraph*). Applicants respectfully submit, however, that the backing layer 58 is not a "*resilient base*."

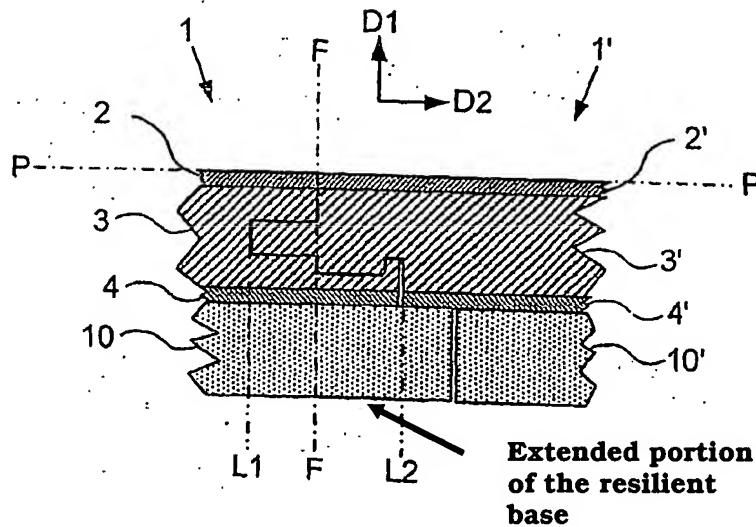
By contrast, referring to paragraph [0015] in the corresponding patent publication US 2006/0174974, a "*resilient base*" as taught by the claimed invention may be "an elastic material that is capable of absorbing and emitting energy, i.e., that has a resilient function." Accordingly, since the backing layer 58 of Moriau does not

¹ A claim is anticipated only if each and every element as forth in the claim is found, either expressly or inherently described, in a single prior art reference. See MPEP § 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

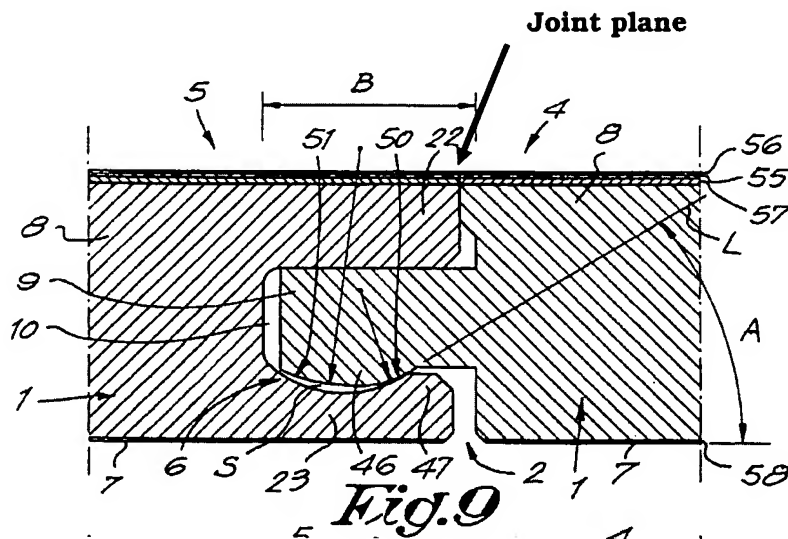
have a resilient function, it cannot be considered a “resilient base.” In fact, the backing layer 58 appears to correspond to instead a “balancing layer” 4 of the claimed invention, whose primary function is to prevent the floorboard from bending when the core 3 and the surface layer 2 are expanded to different degrees. (*See paragraph [0065] of the corresponding patent publication*). Therefore, since the balancing layer 4 is to form a counterbalancing element for the top layers to form stability (col. 9, lines 10-12 of Moriau), it is similar to the feature of the claimed “balancing layer.”

Further, because the Moriau reference fails to disclose or suggest a “resilient base,” it cannot teach or suggest, “a supporting layer, arranged between the underside of the floorboard and the resilient base,” as recited in amended claim 1.

Even assuming *arguendo* that the Moriau reference discloses a “resilient base” (*which Applicants do not agree or admit to*), it does not teach or suggest, “a resilient base extending beyond said joint plane,” as recited in claim 1. In an example, non-limiting embodiment of the claimed invention, FIGS. 1a and 1b illustrate a resilient base 10 extending outside the joint plane F, as in the case with the left floorboard 1. Correspondingly, the resilient base 10' of the right floorboard 1' may be retracted relative to the joint plane F for the purpose of allowing joining of the floorboards 1, 1'. In this respect, **FIG. 1b** of the present application is reproduced below.



In contrast, the backing layer 58 of the Moriau reference does not "extend" beyond the joint plane (as shown below) since the backing layer 58 only extends to the extent of the respective coupling parts 4 and 5. In this respect, FIG. 9 of the Moriau reference is reproduced below.



Therefore, contrary to the Examiner's contention, the Moriau reference does not disclose or suggest each and every element of claim 1. Since the Moriau reference fails

to disclose each and every element of claim 1, it cannot provide a basis for a rejection under 35 U.S.C. § 102(b) and, thus, is allowable.

Claims 19 and 20 are method claims which correspond to claim 1. Applicants respectfully submit that these claims are allowable for the similar reasons presented above in regard to claim 1.

For at least these reasons, the Examiner is respectfully requested to reconsider and withdraw the § 102(b) rejection of claims 1, 14-17, 19 and 20.

Claim Rejections - 35 U.S.C. § 103

Claims 2-12 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moriau. Applicants respectfully traverse this rejection for the reasons discussed below.

Claims 2-12 and 18 are believed to be allowable for at least the reasons set forth above regarding claim 1 and 14. Since claims 2-12 and 18 are patentable at least by virtue of their dependency on either independent claims 1 or 14, Applicants respectfully request that the rejection of claims 2-12 and 18 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these

remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicants do not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number below.

Pursuant to 37 CFR §§ 1.17 and 1.136(a), Applicants petition for a one (1) month extension of time for filing a reply to the October 2, 2008 Office Action, and submit the required \$120.00 extension fee herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By  #48078
Donald J. Daley, Reg. No. 34,313

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

DJD/DJC:clc